

REMARKS

In the Office Action, the Examiner objected to the specification because the specification included hyperlinks. The specification has been amended to remove the hyperlinks. Applicants request that the Examiner's objection to the specification be withdrawn.

Applicants note that the claim number 47 was repeated in the original claims. The claims have been renumbered to remove the typographical error. Thus, claims 1-18, 24-29, and 32-48 are pending in the present application. In the Office Action, the Examiner indicated that claims 40-47 are allowed. In view of the aforementioned typographical error, Applicants believe that claims 40-48 are allowed.

Applicants note that the Examiner has provided contrary indications as to the disposition of some of the pending claims in the Office Action Summary and the Detailed Action. The following summary represents Applicants understanding of the current disposition of the pending claims. In the Office Action, claims 1-3, 6-7, 11-18, 24-25, 27-29, 32-33, and 35-38 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Lindsay, et al (U.S. Patent Publication No. 2002/0194415). Claim 5 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lindsay in view of any one of Hwang (U.S. Patent No. 6,516,398), Ma, et al (U.S. Patent No. 6,182,235), or Dea, et al (U.S. Patent No. 5,742,833). Claims 8-9 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lindsay in view of admitted prior art. The Examiner's rejections are respectfully traversed.

Lindsay describes a network controller having a multi-protocol bus interface adapter coupled between a communication network and a computer bus. However, as admitted by the Examiner at item 8 on page 7 of the Office Action, Lindsay does not describe or suggest an integrated circuit configured as a bridge, as set forth in independent claims 1, 24, 32, and 35. For

at least this reason, Applicants respectfully submit that claims 1-3, 6-7, 11-18, 24-25, 27-29, 32-33, and 35-38 are not anticipated by Lindsay.

Moreover, it is respectfully submitted that the pending claims are not obvious in view of the cited references. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

At item 8 on page 7 of the Office Action, the Examiner alleges that it would have been obvious to combine the teachings of Lindsay with the south bridge described in the background section of the Patent Application. The Examiner also alleges that a person of ordinary skill in the art would be motivated to modify Lindsay in the aforementioned manner so as to allow for the expansion of Lindsay's system to include additional protocols. Applicants respectfully disagree and submit that the Examiner has provided no record support for this conclusory statement. To the contrary, the cited references appear to be completely silent with regard to the Examiner's proposed modification. Thus, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case that the present invention is obvious over the cited references and request that the Examiner's rejections of claims 5 and 8-9 under 35 U.S.C. § 103(a) be withdrawn.


In the Office Action, the Examiner objected to claims 4, 10, 26, 34, and 39 as being dependent upon a rejected base claim, but indicated that these claims include allowable subject matter. In view of the above amendments and/or arguments, Applicants respectfully submit that claims 4, 10, 26, 34, and 39 are allowable and request that the Examiner's objections to these claims be withdrawn.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Date: _____

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